

REMARKS

Prior to entry of this amendment, claims 1-31 are currently pending in the subject application. Claims 9-15 and 22-28 are withdrawn from consideration. Claims 1 and 17 are independent. By the instant amendment, claims 1 and 17 have been amended.

A. Introduction

In the outstanding Office Action Made Final, the Examiner rejected claims 5-8 and 19-21 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement; rejected claims 1 and 17 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention; rejected claims 1, 3-5, 17-19 and 29 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,253,097 to Aronow et al. (hereinafter referred to as “the Aronow et al. reference”) further in view of U.S. Patent No. 4,580,574 to Gavish (hereinafter referred to as “the Gavish reference”); rejected claims 2 and 30-31 under 35 U.S.C. § 103(a) as being unpatentable over the Aronow et al. reference and the Gavish reference and further in view of U.S. Patent No. 6,606,509 to Schmitt (hereinafter referred to as “the Schmitt reference”); rejected claims 6 and 20 under 35 U.S.C. § 103(a) as being unpatentable over the Aronow et al. reference and the Gavish reference and further in view of U.S. Patent No. 5,427,093 to Ogawa et al. (hereinafter referred to as “the Ogawa et al. reference”); indicated that claims 7, 8, and 21 would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112, first paragraph, and to include all the limitations of the base claim and any intervening claims; and objected to claim 16 as being dependent upon a rejected base claim, but indicated that it would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

B. Asserted Indefiniteness Rejections of Claims 5-8 and 19-21

In the outstanding Office Action Made Final, the Examiner rejected claims 5-8 and 19-21 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. More specifically, the Examiner asserted on page 2 of the Office action of April 12, 2007 that application of pressure by the pressure unit is unclear because “[a]s pictured in figure 2 when one turns the bolt the only thing that will happen is the bolt will move further into the nut since there is no supporting member to hold the nut or the bolt fixed.” In response, applicants respectfully direct the attention of the Examiner to the section of the specification describing the pressure application unit 53, on page 17 in paragraph [0037]:

The pressure application unit 53 includes a bolt 52 and a nut 54. The bolt 52 and the nut 54 are screw coupled. When the bolt 52 is turned, the nut moves downwardly in a vertical direction, preferably, along the optical axis that optically connects a center of the light source unit 58 and a center of the photodetector unit 60. Alternatively, the bolt 52 and the nut 54 may be formed as an integrated single body that moves vertically along the optical axis. In this case, when the bolt 52 and the nut 54, which are combined together, are turned in the same direction, the nut 54 engages a threaded portion (not shown) formed on an inner wall of the body 50. The pressure application unit 53 may be pushed manually by the subject or may be engaged automatically when the object 62 reaches a given position in the probe.

In other words, when the nut and bolt are screw coupled, as indicated in ¶ 37 above, a ***coupled rotation of the nut and bolt as a single unit*** in a downward direction along “a threaded portion (not shown) formed on an inner wall of the body 50” may exert pressure on a unit below the nut, e.g., light source. *Id.* More specifically, when a bolt is longer than a nut, rotation of the bolt alone inside the nut may be stopped upon contact between the bolt and the bottom of the nut, i.e., the bolt may be fixed relatively to the nut. Accordingly, a continued rotation of the bolt may produce a coupled rotation of the bolt with the nut in a downward direction to exert pressure.

Therefore, applicants respectfully submit that the specification as filed is fully enabling of the limitations recited in claims 5-8 and 19-22, and that it is well within the ability of one of ordinary skill in the art to assemble, without undue experimentation, the bolt and nut to form a pressure unit as described in the specification. Accordingly, applicants respectfully request favorable reconsideration and withdrawal of the rejection of claims 5-8 and 19-22 under 35 U.S.C. § 112, first paragraph.

C. Asserted Indefiniteness Rejections of Claims 1 and 17

In the outstanding Office Action Made Final, the Examiner rejected claims 1 and 17 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Applicants respectfully submit that ¶ 35 of the specification has been amended to clarify allegedly unclear language indicated by the Examiner. With respect to amended ¶ 35, applicants respectfully submit that no new matter has been added. In particular, it is believed that a vertical axis connecting centers of the light source unit 58 and the photodetector unit 60 is implicitly defined in the original specification. In this respect, the Examiner's attention is directed to at least original ¶ 35 and FIG. 2 of the specification, where the light source unit 58 and the photodetector unit 60 are indicated on the upper and lower horizontal portions of the body 50, respectively. Since the upper and lower horizontal portions of the body 50 are parallel, *lines 4-5 in ¶ 35*, and the light source unit 58 and the photodetector unit 60 are coaxial, *last two lines in original ¶ 35*, a vertical axis crossing centers of the light source unit 58 and the photodetector unit 60 is clearly implicitly defined in the original specification.

In view of the above, it is believed that the rejection under 35 U.S.C. § 112, second paragraph, has been overcome by the preceding amendment, and applicants respectfully request

favorable reconsideration and withdrawal of the rejections of claims 1 and 17 under 35 U.S.C. § 112, second paragraph.

D. Asserted Obviousness Rejection of Claims 1, 3-5, 17-19 and 29

In the outstanding Office Action Made Final, the Examiner rejected claims 1, 3-5, 17-19 and 29 under 35 U.S.C. § 103(a) as being unpatentable over the Aronow et al. reference further in view of the Gavish reference. Applicants respectfully traverse the obviousness rejection and request its favorable reconsideration and withdrawal for at least the reasons set forth below.

It is well settled law that in order to establish a *prima facie* obviousness of an invention, a “prior art reference (or references when combined) must teach or suggest all the claim limitations.” *MPEP*, 706.02(j). Amended independent claims 1 and 17, as supported at least by amended paragraph [0035], recite, *inter alia*,

a light source unit including ***a light source that contacts a predetermined site of an object*** and emits light onto the predetermined site

...

a body ... in which the light source unit and the photodetector unit are positioned in a ***same vertical axis with respect to a surface supporting the body***...

a pressure application unit coupled to the body for ***applying a pressure*** to the object ***via the light source unit***...

In other words, the probe, as recited in claims 1 and 17, includes, *inter alia*, a light source in contact with the object to be tested and vertically aligned with a photodetector unit, and a pressure unit that exerts pressure by applying force through the light source. Neither of the cited prior art references, alone or in combination, disclose or suggest the subject matter recited in claims 1 and 17. In particular, applicants respectfully submit that both the Aronow et al. reference and the Gavish reference fail to disclose, or even suggest, similar structures of a light source, a photodetector unit, and a pressure unit as recited in claims 1 and 17. As such, no *prima*

facie obviousness is established due to lack of proper teaching or suggestion of each and every element recited in claims 1 and 17 exist.

In view of the above, applicants respectfully submit that the references cited by the Examiner cannot be said to suggest the subject matter of claims 1 and 17, much less propose a proper modification thereof. Accordingly, applicants respectfully request that the rejection of claims 1, 17, and claims dependent thereon be favorably reconsidered and withdrawn.

E. Asserted Obviousness Rejection of Claims 2, 6, 20 and 30-31

In the outstanding Office Action Made Final, the Examiner rejected claims 2, 6, 20 and 30-31 under 35 U.S.C. § 103(a) as being unpatentable over the Aronow et al. reference and the Gavish reference and further in view of either the Schmitt reference or the Ogawa et al. reference. However, applicants respectfully submit that neither the Schmitt reference nor the Ogawa et al. reference supply the teachings noted above as missing from the Aronow et al. and Gavish references. Accordingly, applicants traverse this rejection and respectively submit that claims 2, 6, 20 and 30-31 are allowable for at least the reasons set forth above regarding claims 1 and 17.

F. Allowable Subject Matter

Applicant appreciates the Examiner's indication of allowable subject matter in claims 7, 8, 16, and 21. Claims 7, 8, 16, and 21 depend, directly or indirectly, from independent claims 1 and 17, which are believed to be in condition for allowance. Accordingly, claims 7, 8, 16, and 21 are believed to be similarly allowable as depending from an allowable base claim. Thus, reconsideration and withdrawal of the objections to claims 7, 8, 16, and 21 is respectfully requested.

G. Entry of Amendment Requested

Applicant respectfully submits that the pending claims are in condition for allowance, and that the instant amendments overcome the rejections set forth in the outstanding Office action. Further, the instant amendment merely clarifies language noted by the Examiner. Accordingly, it is respectfully submitted that consideration of the instant amendment does not place an undue burden on the Examiner, and entry of the above amendment after final is respectfully requested.

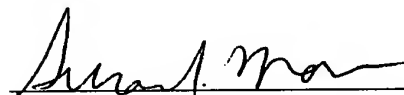
H. Conclusion

In view of the foregoing amendments and remarks, reconsideration of this application is earnestly solicited, and an early and favorable further action upon all the claims is hereby requested. Upon allowance, rejoinder of the withdrawn claims is respectfully requested.

If the Examiner believes that additional discussions or information might advance the prosecution of the instant application, the Examiner is invited to contact the undersigned at the telephone number listed below to expedite resolution of any outstanding issues.

Respectfully submitted,

LEE & MORSE, P.C.



Susan S. Morse, Reg. No. 35,292

Date: August 9, 2007

LEE & MORSE, P.C.
3141 FAIRVIEW PARK DRIVE
SUITE 500
FALLS CHURCH, VA 22042
703.207.0008 TEL
703.207.0003 FAX

PETITION and
DEPOSIT ACCOUNT CHARGE AUTHORIZATION

This document and any concurrently filed papers are believed to be timely. Should any extension of the term be required, applicant hereby petitions the Director for such extension and requests that any applicable petition fee be charged to Deposit Account No. 50-1645.

If fee payment is enclosed, this amount is believed to be correct. However, the Director is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 50-1645.

Any additional fee(s) necessary to effect the proper and timely filing of the accompanying-papers may also be charged to Deposit Account No. 50-1645.